

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NETLIST, INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., et al.,

Defendants.

Civil No. 2:22-cv-00293-JRG
(Lead Case)

JURY TRIAL DEMANDED

NETLIST, INC.,

Plaintiff,

v.

MICRON TECHNOLOGY TEXAS, LLC, et al.,

Defendants.

Civil No. 2:22-cv-00294-JRG
(Member Case)

JURY TRIAL DEMANDED

**SAMSUNG'S SUR-REPLY TO NETLIST'S MOTION FOR SUMMARY JUDGMENT
ON SAMSUNG'S DEFENSE OF PROSECUTION HISTORY ESTOPPEL (DKT. 349)**



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TABLE OF EXHIBITS TO SAMSUNG'S OPPOSITION

#	Description
A	Prosecution History for <i>Inter Partes</i> Reexamination No. 95/000,578 of U.S. Patent No. 7,619,912 (SAM-NET-293_00026272) (excerpts)
B	December 31, 2014, Amendment Response to Office Action, Application No. 13/952,599, now U.S. Patent No. 9,128,632
C	January 25, 2018, Office Action, U.S. Patent Application No. 15/820,076, now U.S. Patent No. 10,268,608
D	Terminal Disclaimer, U.S. Patent Application No. 15/820,076, now U.S. Patent No. 10,268,608
E	Declaration of Joseph C. McAlexander III (excerpts)

TABLE OF ABBREVIATIONS

Abbreviation	Description
'608 patent	U.S. Patent No. 10,268,608
'632 patent	U.S. Patent No. 9,128,632
'912 patent	U.S. Patent No. 7,619,912
<i>Honeywell I</i>	<i>Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.</i> , 370 F.3d 1131 (Fed. Cir. 2004) (<i>en banc</i>)
<i>Honeywell II</i>	<i>Honeywell Int'l, Inc. v. Hamilton Sundstrand Corp.</i> , 523 F.3d 1304, 1316 (Fed. Cir. 2009)
SRNF	Samsung's Response to Netlist's Statement of Undisputed Facts (Dkt. 468 at 2)
SSMF	Samsung's Statement of Undisputed Material Facts (Dkt. 468 at 2-3)

I. Netlist Cannot Avoid Prosecution History Estoppel for Claim 16 of the '912 Patent

Netlist concedes that it “narrow[ed] the overall scope of its claimed subject matter,” SSMF, ¶¶ 1-3, such that original claim 15—to which claim 16 added only the “command signal is transmitted to only one DDR memory device at a time” limitation—was surrendered. *Compare id.*, with Dkt. 506. Netlist’s argument that this surrender did not give rise to estoppel is contrary to *Festo* and *Honeywell I*. “A patentee’s decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Co.*, 535 U.S. 722, 740 (2002). *Festo* applies equally whether “a preexisting claim limitation is narrowed by amendment,” “a new claim limitation is added by amendment,” the patentee “rewrit[es] a dependent claim into independent form” and “cancel[s] the original independent claim,” or “a narrower rewritten claim [is] substituted for [a] broader original independent claim.” *Honeywell Int’l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1140-44 (Fed. Cir. 2004) (*en banc*).

Under *Festo*’s and *Honeywell I*’s reasoning, Netlist’s narrowing amendments presumptively give rise to prosecution history estoppel. *Festo*, 535 U.S. at 736-37, 740; *Honeywell I*, 370 F.3d at 1141-44. Netlist’s reliance on *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 2010 WL 1485326, at *2-3 (D. Del. Apr. 12, 2010), and its attempt to limit *Honeywell I* to its facts (where the original independent claim is “cancelled”) are wrong; this Court is “bound not only by” *Honeywell I*’s specific holding, but also by its reasoning, *Troy v. Samson Mfg. Corp.*, 758 F.3d 1322, 1326 (Fed. Cir. 2014), which applies equally here. Indeed, Netlist admits it narrowed claim 15’s scope and does not identify **any** reason why abandoning original claim 15 one way (by making narrowing amendments to it) should be treated differently than abandoning it another way (cancellation). Dkt. 506. There is no basis for such an exception to *Festo*. See *Dubn Oil Tool, Inc. v. Cooper Cameron Corp.*, 757 F. Supp. 2d 1006, 1027-28 (E.D. Cal. 2010). The *Festo* presumption applies to the “command signal is transmitted to only one DDR memory device at a time” limitation because that is the “territory between” what surrendered original

claim 15 claimed and what claim 16 now claims. *Festo*, 535 U.S. 722 at 740; *Honeywell I*, 370 F.3d at 1144 (“Equivalents are presumptively not available with respect to [an] added limitation” of a dependent claim rewritten in independent form after surrender of original independent claim.).

In arguing that the amendment was only tangentiality related to the reason for the amendment, Netlist ignores its failure to satisfy the requirement of identifying an “objectively apparent” reason for the amendment in the prosecution history. Dkt. 468 at 5 (citing *Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1184 (Fed. Cir. 2009)). Netlist also fails to distinguish *Honeywell II*, holding that equivalents related to the limitation added by “the original dependent claim” are “not tangential.” *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316 (Fed. Cir. 2009). Finally, Netlist never rebuts Mr. McAlexander’s opinion that Netlist’s alleged equivalent regarding [REDACTED]

[REDACTED] Ex. E ¶ 282. The narrow tangentiality exception does not apply.

II. Netlist’s ’632 Patent Amendments Create Estoppel for the ’608 Patent

Fatal to its assertion that the ’632 patent amendments involved a different limitation, Netlist does not identify any material difference between the ’608 patent’s recitation of delaying a data signal “by an amount determined by the command processing circuit in response to at least one of the module control signals” and the ’632 patent’s requirement of “determin[ing] a respective time interval based on signals received” and “tim[ing] transmission . . . in accordance with the time interval.” SSMF ¶¶ 5-6. The two limitations are thus the same “specific limitation” for purposes of prosecution history estoppel. *Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 259-60 (Fed. Cir. 1985). Netlist also does not dispute that this limitation was added to avoid prior art that otherwise taught delaying data signals. SSMF ¶ 5. Thus, this is a classic case of prosecution history estoppel in a parent application applying to the child. *E.g., Mark I Mktg. Corp. v. R.R. Donnelly & Sons Co.*, 66 F.3d 285, 291 (Fed. Cir. 1995). Netlist’s motion should be denied.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on February 14, 2024. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A) and via electronic mail.

/s/ Lauren A. Degan

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